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PATENT

Attorney Docket No.: A-68718-4/RFT/RMS/RMK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

BLACKBURN, et al.

Serial No.: 09/993,342

Filed: November 5, 2001

For: DEVICES AND METHODS FOR
BIOCHIP MULTIPLEXING

Examiner: Not Assigned

Group Art Unit: 1744

CERTIFICATE OF MAILING

I hereby certify that this correspondence, including listed
enclosures, is being deposited with the United States
Postal Service as First Class Mail in an envelope addressed
to: Box Missing Parts, Assistant Commissioner for
Patents, Washington, DC 20231 on July 8, 2002.

Signed: Monica E. Carlos
Monica E. Carlos

RECEIVED

JUL 16 2002

OFFICE OF PETITIONS

PETITION UNDER 37 C.F.R. § 1.47(a)

Box Missing Parts
Assistant Commissioner of Patents
Washington, DC 20231

Sir:

The following is a petition under 37 C.F.R. § 1.47(a) to accept the enclosed
declaration, which is missing the signature of one of the co-inventors. Applicants enclose
a fee of \$130.00 as required under 37 C.F.R. § 1.17(h) in support of this petition.

The Commissioner is authorized to charge any additional fees which may be
required or credit any overpayment to Deposit Account No. 06-1300 (Our Order No.
A68718-4/RFT/RMS/RMK).

Renee Kossiak is the attorney who prepared the above-identified application. In
this application and in this petition under 37 C.F.R. § 1.47, she represents the interests of
Clinical Micro Sensors, Inc. (Hereinafter "CMS").

Upon information and belief, the subject matter of the application was conceived
and developed by Gary F. Blackburn, Hau H. Duong, Piotr Grodzinski, Jon F. Kayyem,
Stephen D. O'Connor, Gary T. Olsen, Robert Pietri, Robert H. Terbrueggen, and Frederic

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Zenhausern (the 'inventors'). Gary F. Blackburn, Hau H. Duong, Piotr Grodzinski, Jon F. Kayyem, Gary T. Olsen, Robert Pietri, Robert H. Terbrueggen, and Frederic Zenhausern have signed the declaration for the application and assignment of the application to CMS.

The application was prepared based partly on utility applications U.S.S.N. 09/760,384, filed January 1, 2001, in the names of Hau H. Duong, Gary Blackburn, Jon F. Kayyem, Stephen D. O'Connor, Gary T. Olsen, Robert Pietri, and Robert H. Terbrueggen; and utility application U.S.S.N. 09/904,175, filed July 11, 2001, in the names of Hau H. Duong, Gary Blackburn, Jon F. Kayyem, Stephen D. O'Connor, Gary T. Olsen, Robert Pietri, Nathan Swami and Robert H. Terbrueggen. As both of these utility applications were device oriented applications, they were prepared with the assistance (including scientific input and/or data) of Stephen D. O'Connor and he signed the Declaration and Assignment for both applications.

On February 13 1999 Stephen D. O'Connor terminated his status as an employee of CMS.

After receiving the Notice to File Missing Parts, a letter was sent by Renee Kossalak to CMS on June 28, 2002 requesting that the declaration and assignment be signed and dated by each inventor. A copy of the letter requesting that the declaration and assignment be signed and dated is attached as Exhibit 1.

On July 8, 2002, Stephen D. O'Connor notified Renee Kossalak, via telephone, that he did not want to review the present application as it contained subject matter on microfluidics. In a separately placed phone call, Stephen O'Connor also notified Robin M. Silva, the partner in charge of this case, that he did not want to review the present application.

On July 8, 2002, Stephen D. O'Connor was notified, via facsimile, that if he did not want to review or receive confidential CMS information, including the pending application, that this would be interpreted as an express refusal to sign the "Declaration for Patent Application". A copy of the facsimile is attached as Exhibit 2.

On July 8, 2000 Stephen D. O'Connor, via facsimile, confirmed in writing his refusal to sign the "Declaration for Patent Application". A copy of this facsimile is attached as Exhibit 3.

Stephen D. O'Connor is obligated by agreement with CMS to assign his entire interest in the subject matter of the application to CMS. A copy of the Agreement executed by Stephen D. O'Connor when he joined CMS is attached as Exhibit 4. Section 2(b) of the Agreement requires the assignment of all inventions made by the employee in the course of her employment. Section 2(e) of the Agreement requires that the employee assist the Company in obtaining patent rights covering all inventions and original works of authorship assigned to the Company and that this obligation shall continue beyond termination of employment.

In accordance with the employment agreement, Section 2(e), Dr. Jon F. Kayyem has signed the assignment on Stephen D. O'Connor's behalf.


Stephen D. O'Connor currently resides at 1892 Galbrath Road, Pasadena, California 91104.

Accordingly, as required by 37 C.F.R. §1.47 and M.P.E.P. §409.03(a), the applicants have met the requirements for proving a refusal to sign the declaration and assignment. These requirements are: (1) a declaration signed by all available joint inventors. Applicants note that under M.P.E.P. §409.03(a)(A)(2) that a declaration signed by all available joint inventors with the signature block of the non-signing inventor left

blank may be treated as having been signed by all the available joint inventors on behalf of the non-signing inventor; (2) this petition is accompanied by proof that the non-signing inventor refuses to execute the papers; and, (3) the last know address of the non-signing inventor is stated.

Dated: 7/8/02, 2002

Respectfully submitted,
DORSEY & WHITNEY LLP

By: 
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